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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,690	03/29/2004	J. Christopher Marmo	D-4109	1370
61535	7590	03/14/2007		
FRANK J. UXA STOUT, UXA, BUYAN & MULLINS, LLP 4 VENTURE, SUITE 300 IRVINE, CA 92618			EXAMINER NUTTER, NATHAN M	
			ART UNIT	PAPER NUMBER
			1711	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/14/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/811,690

Applicant(s)

MARMO, J. CHRISTOPHER

Examiner

Nathan M. Nutter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --.

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 114-171 is/are pending in the application.
- 4a) Of the above claim(s) 127-171 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 114-126 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Newly submitted claims 127-171 are directed to inventions that are independent or distinct from the invention originally claimed for the following reasons:

1) claims 127-141 recite "a seal surrounding the cavity to maintain the contact lens in a sterile environment," which was not within the scope of the claims as originally examined,

2) claims 142-156 recite "a seal surrounding the cavity to maintain the contact lens in a sterile environment," which was not within the scope of the claims as originally examined, and

3) claims 157-171 recite "a reaction product of a polymerizable composition," which is of a different scope than the originally claimed mixture of resins.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 127-171 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claims 114-126 remain pending for prosecution.

Response to Amendment

In response to the amendment filed 2 February 2007, the following is placed in effect.

The rejection of claims 4, 7, 10, 19, 22, 24 and 27 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement, is hereby expressly withdrawn.

The rejection of claims 4, 7, 10, 16, 19, 22, 24, 27, 32, 34-36, 38, 40 and 42-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, is hereby expressly withdrawn.

The rejection of claims 1-4, 6, 7, 10, 11, 14, 16-19, 22, 24, 26-28, 30, 32-36, 38, 40 and 42-45 under 35 U.S.C. 102(b) as being anticipated by Hu et al (US 2001/0044482), is hereby expressly withdrawn.

The rejection of claims 1-4, 6, 7, 10, 11, 14, 16-19, 22, 24, 26-28, 30, 32-36, 38, 40 and 42-45 under 35 U.S.C. 102(b) as being anticipated by Gordon (US 4,123,408), is hereby expressly withdrawn.

The rejection of claims 1-4, 6, 7, 10, 11, 14, 16-19, 22, 24, 26-28, 30, 32-36, 38, 40 and 42-45 under 35 U.S.C. 102(b) as being anticipated by Shah (US 4,462,665), is hereby expressly withdrawn.

The rejection of claims 1-3, 10, 16-19 and 27 under 35 U.S.C. 102(b) as being anticipated by Tanaka et al (US 6,008,170), is hereby expressly withdrawn.

The rejection of claims 1-3, 10, 16-19 and 27 under 35 U.S.C. 102(b) as being anticipated by Salpekar et al (US 6,440,366), is hereby expressly withdrawn.

The following new grounds of rejection are being made.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 114-126 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hu et al (US 2001/0044482), Gordon (US 4,123,408), or Shah (US 4,462,665), all previously cited, each taken in view of Dziabo et al (US 5,338,408), Krezanoski et al (US 3,954,644), Huth et al (US 4,460,573) and Park et al (US 5,882,678), all newly cited.

The reference to Hu et al (US 2001/0044482) shows the contemplated contact lens employed in the instant claims at the Abstract, paragraphs [0017]-[0019], [0022], [0029], [0032]-[0035], [0047]-[0048], [0051] and the many Examples.

The reference to Gordon (US 4,123,408) shows the contemplated contact lens employed in the instant claims at the Abstract, column 2 (lines 38-55), column 3 (line 64) to column 6 (line 63), the Example at columns 8 and 9 and the claims.

The reference to Shah (US 4,462,665) shows the contemplated contact lens employed in the instant claims at the Abstract, column 2 (line 1) to column 4 (line 49), the many Examples and the claims.

Each of the references to Dziabo et al (US 5,338,408), Krezanoski et al (US 3,954,644), Huth et al (US 4,460,573) and Park et al (US 5,882,678) show the storage

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and cleaning of contact lenses using polymers, as herein recited and claimed. Note in Dziabo et al at the paragraph bridging column 5 to column 6) for the use of polymers derived from vinyl ethers (claim 122), polyacrylates and polyacrylic acids (claims 123 and 124), polyvinyl pyrrolidone (lactam) (claim 125), and polyvinyl alcohol (claim 126). The reference to Park et al shows the storage of contact lenses in the disinfectant/cleaning compositions and teaches specifically polyacrylates (claim 123), polyacrylic acid (claim 124) and polymethacrylic acid (claim 126) in a package system, as recited herein. Note column 2 (lines 35-63). The reference to Huth et al shows the use of PVP (claim 125) for "contact lens care," such as storage. Note the Abstract. The patent to Krezanoski et al shows the use of vinyl ethers for storage and cleaning of contact lenses. Note the Abstract.

The primary references teach the contact lens of the claims. The secondary references show the solutions for cleaning/storage and show such as conventional, as recited herein. The employment of a package is notoriously obvious since the product must be vended and distributed. As such, a skilled artisan would have a high level of expectation of success following the teachings of the references. Nothing unexpected is shown on the record.

Claims 114-116 and 122-126 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka et al (US 6,008,170) or Salpekar et al (US 6,440,366), each taken in view of Dziabo et al (US 5,338,408), Krezanoski et al (US 3,954,644), Huth et al (US 4,460,573) or Park et al (US 5,882,678).

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The reference to Tanaka et al (US 6,008,170) shows the contemplated contact lens employed in the instant claims at the Abstract, the paragraph bridging column 3 to column 4, column 6 (lines 45-61), the Examples and claims.

The reference to Salpekar et al (US 6,440,366) shows the contemplated contact lens employed in the instant claims at the Abstract, column 3 (line 53) to column 7 (line 57), the Examples and the claims.

Each of the references to Dziabo et al (US 5,338,408), Krezanoski et al (US 3,954,644), Huth et al (US 4,460,573) and Park et al (US 5,882,678) show the storage and cleaning of contact lenses using polymers, as herein recited and claimed. Note in Dziabo et al at the paragraph bridging column 5 to column 6) for the use of polymers derived from vinyl ethers (claim 122), polyacrylates and polyacrylic acids (claims 123 and 124), polyvinyl pyrrolidone (lactam) (claim 125), and polyvinyl alcohol (claim 126). The reference to Park et al shows the storage of contact lenses in the disinfectant/cleaning compositions and teaches specifically polyacrylates (claim 123), polyacrylic acid (claim 124) and polymethacrylic acid (claim 126) in a package system, as recited herein. Note column 2 (lines 35-63). The reference to Huth et al shows the use of PVP (claim 125) for "contact lens care," such as storage. Note the Abstract. The patent to Krezanoski et al shows the use of vinyl ethers for storage and cleaning of contact lenses. Note the Abstract.

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Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new grounds of rejection.

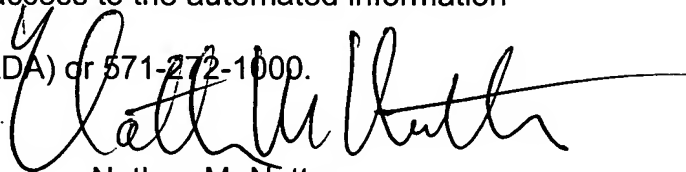
Due to the new grounds of rejection, this action is not being made FINAL.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 571-272-1076. The examiner can normally be reached on 9:30 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Nathan M. Nutter
Primary Examiner
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nmn

13 March 2007